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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,301	12/30/2003	Xing Su	INTEL1240 (P16229)	1668
28213	7590	06/20/2006	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US, LLP			YU, MELANIE J	
4365 EXECUTIVE DRIVE			ART UNIT	
SUITE 1100			PAPER NUMBER	
SAN DIEGO, CA 92121-2133			1641	

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/750,301

Applicant(s)

SU ET AL.

Examiner

Melanie Yu

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-12, 33 and 34.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No.(s) 7/25

13. ☐ Other: _____.

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Continuation of 11. does NOT place the application in condition for allowance because: for the reasons stated in the examiner's previous office action dated 17 March 2006.

Applicant argues that Schultz discloses separation of PRPs in a gel and do not teach SERS enhancing nanoparticles contained or incorporated in the gel while the instant claims require SERS-enhancing nanoparticles within the gel and also having an attached probe. Applicant argues that the PRPs being separated in the gel do not disclose having an attached probe. However, in response to applicant's arguments, it is noted that at column 23, lines 40-48 and 54-61, Schultz teaches that PRPs may have an attached probe that binds to specifically to analyte and at column 30, lines 58-66, PRPs may be contained within a gel. It is noted that the passage describing PRPs within an electrophoresis gel is described at a different passage where probes are bound to the PRPs. However, properties of the nanoparticles do not need to be disclosed in the same portion of the reference and all embodiments of the reference must be considered. Schultz does not teach that the PRPs contained in the electrophoresis gel do not contain probes for analyte at column 30, lines 58-66 and therefore the PRPs contained within the electrophoresis gel at column 30, lines 58-66 may comprise an attached probe as taught at column 23, lines 40-48 and 54-61.

Applicant further argues that the elements of Schultz are not "arranged as required by the claim" because many different passages in Schultz are cited with many of the cited passages related to different embodiments and the elements in Schultz are randomly located in the reference spanning twenty-four columns and are not arranged as required by the claim. Applicant further argues that Schultz does not disclose PRPs with probes within a gel or PRPs with probes that are used to bind specifically to an analyte for separation of biomolecules within the gel. This argument is not persuasive because the instant claims are directed to:

- * a gel capable of separation of biomolecules within the gel by electrophoresis

- * one or more SERS enhancing nanoparticles contained in the gel

- * a probe attached to the SERS enhancing nanoparticle.

Such a gel is taught in its entirety by Schultz. Schultz teaches:

- * a gel containing nanoparticles (PRPs, col. 30, lines 58-66)

- * these particles are SERS-enhancing nanoparticles (PRPs are SERS-enhancing, col. 14, lines 30-43; PRPs are nanoparticles, col. 8, lines 25-27)

- * these particles also have attached probes for analyte (col. 23, lines 40-48 and 54-61).

Clearly, the particles in the gel are SERS-enhancing nanoparticles with probes for analyte. Therefore, Schultz clearly discloses the claimed invention. The fact that Schultz describes properties of the PRPs and details of different embodiments does not diminish its teachings of the claimed invention. The arguments that the claimed elements are randomly located in the Schultz reference is not persuasive because at least one embodiment taught by Schultz anticipates the claim (col. 30, lines 58-66) and the properties and characteristics comprised by the PRP may be located in different portions of the reference.